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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,325	01/03/2002	Harry W. Eberle III	(HWE-107A)	5841
7590 06/14/2004 KENNETH P. GLYNN, ESQ. Glynn & Associates, P.C. 24 Mine Street Flemington, NJ 08822			EXAMINER GARCIA, ERNESTO	
			ART UNIT 3679	PAPER NUMBER

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/037,325

Applicant(s)

EBERLE, HARRY W.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In view of the appeal brief filed on 4/23/04, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Drawings***

The drawings are objected to because the hatching for the element 1, in Fig 5, is incorrect for plastic material. See MPEP § 608.02. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Zibell, 3,319,983 (see marked-up attachment).

Regarding claim 21, Zibell discloses in Figure 11, an anchoring device comprising a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **W<sub>1</sub>** as measured side to side. The first width **W<sub>1</sub>** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second

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width **W<sub>2</sub>** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **W<sub>3</sub>** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **W<sub>1</sub>** is greater than the second width **W<sub>2</sub>** and the third width **W<sub>3</sub>**. The third width **W<sub>3</sub>** is greater than the second width **W<sub>2</sub>**.

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Fisher et al., 5,704,181 (see marked-up attachment).

Regarding claim 21, Fisher et al. disclose, in Figure 3, an anchoring device comprising a substantially flat horizontal top element **14b**, at least one substantially vertical support member **14c**, and a substantially flat horizontal bottom element **14a**.

The top element **14b** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **14b** has an imaginary center line **A4**. The support member **14c** is attached to an underside **A6** of the top element **14b** along the center line **A4** and the support member **14c** extends downwardly therefrom. The support member **14c** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **14a** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Claims 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Great Britain patent, GB-1,350,754.

Regarding claim 21, see Figure 10.

Regarding claim 23, see column 4, lines 72-84.

Claims 24 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al., 6,363,677 (see marked-up attachment).

Regarding claim 24, Chen discloses in Figure 5, a decking system comprises boards **A20** and an anchoring device **A26**. Each of the boards **A20** has a top **A21**, a bottom **A22**, two sides **A23** and two ends **A24**. At least one groove **A25** is located along one of the sides **A23**. The device **A26** comprises a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration which

includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.

Applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards pre-cut with receiving slots, and to position the bottom element upon a support board, which the two boards rest for attachment of the anchoring device to the support board for anchoring and support the two boards.

Regarding claim 26, the device is made of molded plastic material capable of having a metal fastener driven through (col. 7, lines 56-60).

Regarding claim 27, the groove **A25** establishes an upper half **A30** of each of the boards **A20** above the groove **A25** and a lower half **A31** of each of the boards **A20** below the groove **A25**. The upper half **A30** has a greater width than the lower half **A31**. Compare widths **A32** and **A33**.



Regarding claim 28, the boards **A20** are made of material selected from the group consisting of synthetic polymers, at least partially foamed synthetic polymers, wood, wood composite, and combinations thereof (col. 4, lines 22-50).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181, in view of Naccarato et al., 6,442,908.

Regarding claim 22, Fisher et al., as discussed above, fail to disclose the vertical support member **14c** having recesses with support columns located therebetween. Naccarato et al. teach, in Figs. 4 and 5, a vertical support member **14c** having recesses **15** to promote optimal flow of grout material through the support member (col. 5, lines 29-35). Therefore, as taught by Naccarato et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses in the vertical support member to promote optimal flow of grout material through the support

member. Applicant is reminded that columns will be inherently located between the recesses as shown in Figure 3 of Naccarato et al.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zibell, 3,349,983.

Regarding claim 23, Zibell, as discussed above, fails to disclose the device made of molded plastic material. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of plastic. *In re Leshin*, 125 USPQ 416. Furthermore, it is well known that plastic material is capable of having a metal fastener driven through.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Major, 556,998 (see marked-up attachment), in view of Fisher et al., 5,704,181.

Regarding claim 24, Major, discloses, in Figure 1, a decking system comprising boards **B** and an anchoring device **A**. Each of the boards **B** has a top **e**, a bottom **c**, two sides **12** and two ends (Fig. 2A). At least one groove **l** is located along one of the sides **12**. The device **A** comprises a substantially flat horizontal top element **k**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom

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element **A9**. The top element **k** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **k** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **k** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration which includes sides **A10**, and a predetermined third width **A11** as measured side to side at a maximum width at a base. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.

However, Major, fails to disclose, the bottom element **A9** having a generally trapezoidal shape. Fisher et al. teach, in Figure 3, a bottom element **14a** of an anchoring device comprising a trapezoidal shape to have a dissymmetric anchoring device so that it increase load-bearing capacity (col. 4, lines 17-36). Therefore, as taught by Fisher et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the bottom element having a generally trapezoidal shape so that the anchoring device has a dissymmetric shape to increase load-bearing capacity. Note, the base will be a trapezoidal base due to the horizontal bottom element having a trapezoidal shape.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Major, 556,998, in view of Fisher et al., 5,704,181, as applied to claim 24 above, and further in view of Naccarato, 6,442,908.

Regarding claim 25, Major, as modified above, fails disclose the vertical support member **14c** having recesses with support columns located therebetween. Naccarato et al. teach, in Figs. 4 and 5, a vertical support member **14c** having recesses 15 to promote optimal flow of grout material through the support member (col. 5, lines 29-35). Therefore, as taught by Naccarato et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses in the vertical support member to promote optimal flow of grout material through the support member. Applicant is reminded that columns will be inherently located between the recesses as shown in Figure 3 of Naccarato et al.

### ***Response to Arguments***

Applicant's arguments filed 4/23/04 and in respect to claims 21-23 have been fully considered but they are not persuasive.

Applicant has argued that the Zibell does not teach a decking system for claim 21. This is not found persuasive as claim 21 is directed to an anchoring device and not a decking system. The fact that Zibell is not directed to decking systems is irrelevant as

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Zibell shows an anchoring device as claimed. Furthermore, applicant has argued that the device of Zibell does not have a flat bottom or that the flat bottom has a maximum width greater than the maximum width of the center, but instead Zibell teaches the clip maximum center width and the maximum width of the center being identical. This is not persuasive, as the examiner has taken the bottom element to be base B1. The fact that the bottom element has extra features 78 projecting from the bottom is allowed within the scope of the open-ended claim. Furthermore, applicant has argued that the examiner has distorted the center section of Zibell and distorted it by calling the center as the bottom element. In response, it is unclear how applicant concludes the bottom element is the center section of the device. It appears that the applicant has also distorted it by calling it the center section when in fact it is not a center section. In any event, people name things whatever they wish. Some might just call it a base with a flat surface or others might just call it a first portion with a flat surface. As long as the structure in the reference is the same as the structure in the claim then it meets the claim.

### ***Conclusion***

The examiner is withdrawing Zibell against claims 24-28 since Zibell does not disclose a decking system as in a floor decking system as argued. Zibell teaches a wall or a ceiling system.

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nelson, Mitchell et al., German patent, DE-4,036,338, Japanese patent, JP-07-189451 show a similar anchoring device; and, Japanese, patent, JP-07-189451, Great Britain, 2,124,672, and Tremblay show a similar decking system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

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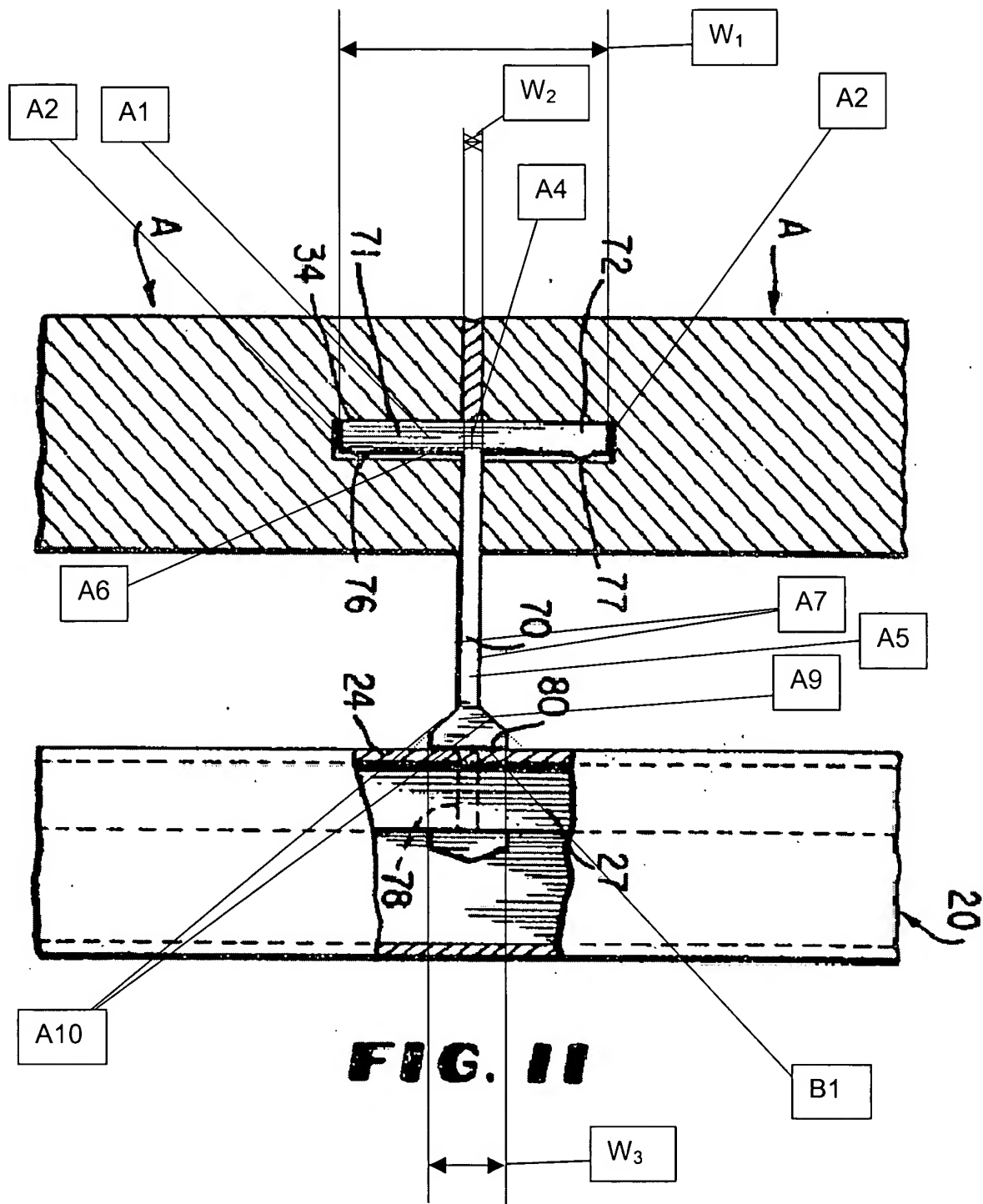
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May 28, 2004

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
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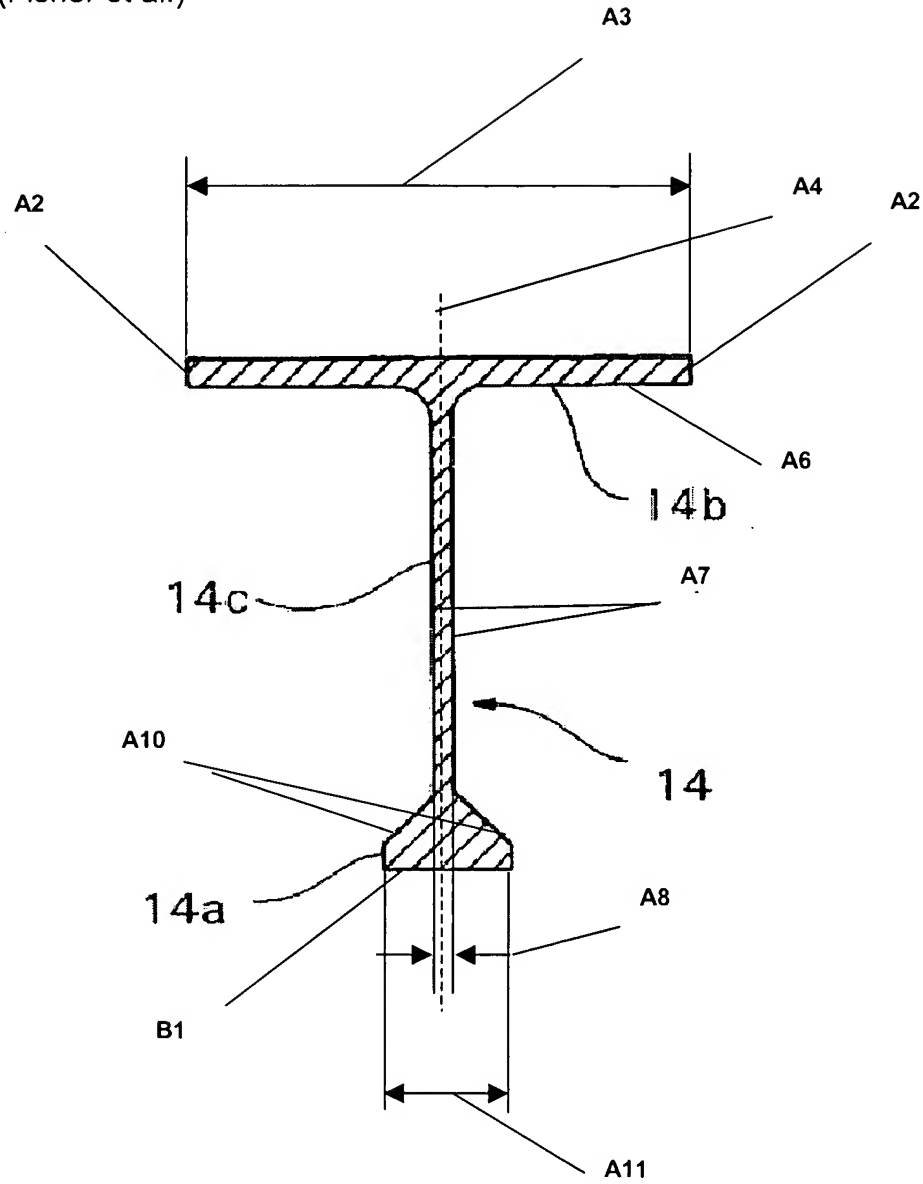
Attachments: one marked-up copy of Zibell, 3,319,983;  
one marked-up copy of Fisher et al., 5,704,181;  
one marked-up copy of Chen et al., 6,363,677; and,  
one marked-up copy of Major, 556,998.

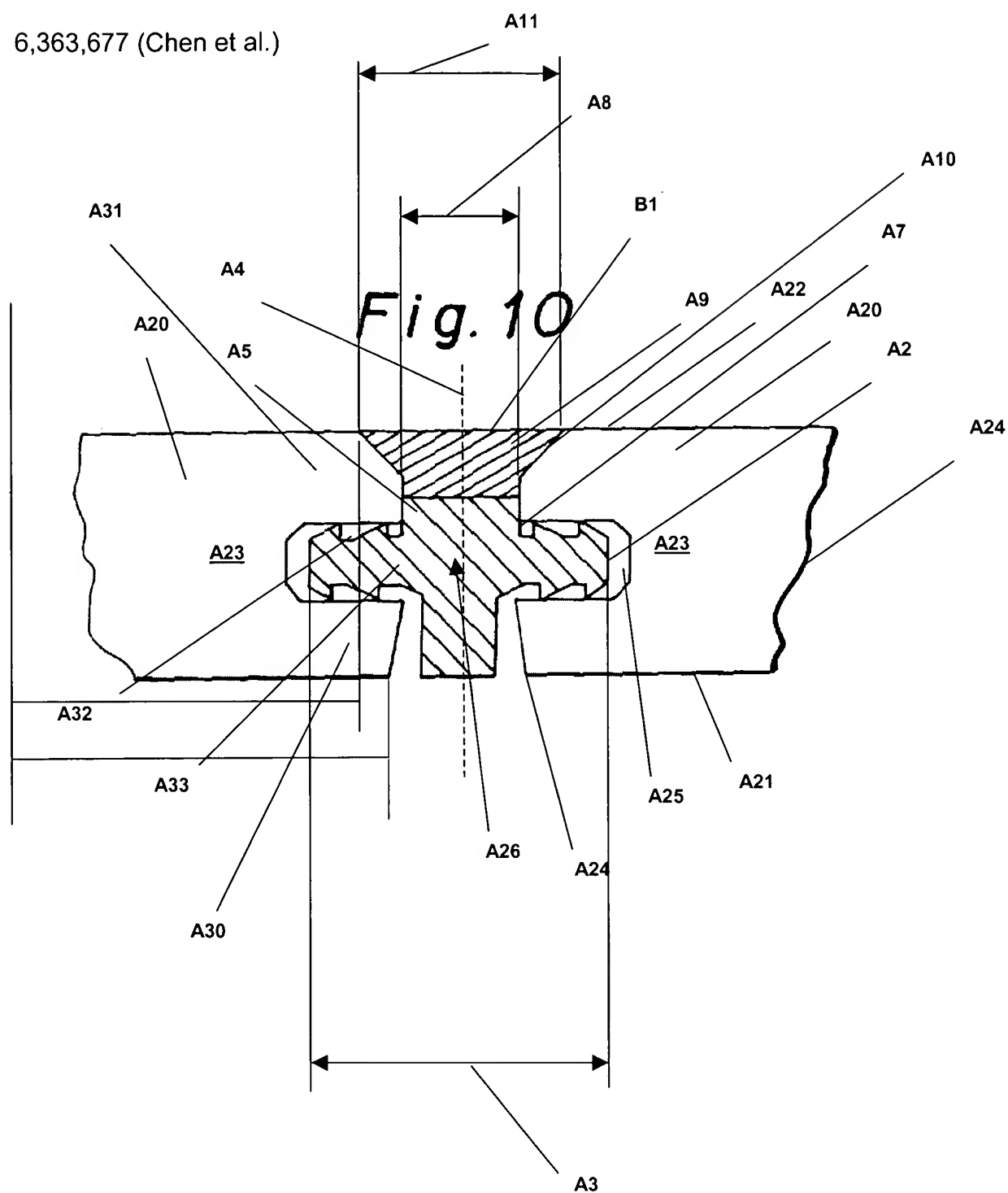
3,319,983 (Zibell)





5,704,181 (Fisher et al.)





556,998 (Major)

